## REMARKS

Claims 1-30 were pending as of the action mailed on September 9, 2008. Claims 1, 11, and 20 are in independent form.

Claims 29 is being amended for clarity. No new matter is added. Reconsideration of the action is respectfully requested in light of the foregoing amendments and the following remarks.

The examiner rejected claims 11-19 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The examiner rejected claims 1-5, 8-14, 17-23, and 26-30 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0069223 ("Goodisman"), in view of U.S. Patent Application Publication No. 2004/0078757 ("Golovchinsky"). The examiner rejected claims 6, 15, and 24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goodisman and Golovchinsky in view of U.S. Patent Application Publication No. 2003/0221163 ("Glover"). The examiner rejected claims 7, 16, and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goodisman, Golovchinsky, and Glover in view of U.S. Patent No. 6,763,496 ("Hennings").

### Specification Objection

The examiner objected to the phrase "machine-readable storage device" recited in claim 11 as lacking antecedent basis in the specification. The applicant respectfully disagrees. The specification discloses a computer-readable medium and identifies a number of examples including memory, memory devices, data storage device, and carrier waves. *See* paragraph 34. Furthermore, the specification need not literally recite all claim features. As set forth in MPEP § 2173.05(e):

> "The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision."

The applicant submits that "machine-readable storage device" provide the necessary clarity and precision as to its meaning. Moreover, the applicant notes that the examiner does not contend that the term lacks enablement or would otherwise be unclear to one of skill in the art. *See* MPEP § 2164. Therefore, the applicant respectfully requests that the examiner withdraw the objection to the specification.

## Section 101 Rejections

The examiner rejected claims 11-19 as directed to non-statutory subject matter. Specifically, the examiner states that it would be reasonable to interpret "machine-readable storage device" as conveying carrier waves. To support this assertion the examiner points to the specification as identifying a "computer-readable medium" as optionally being a carrier wave.

The applicant respectfully disagrees with the examiner's analysis. A machine-readable storage device is distinct from a computer-readable medium. Furthermore, a "storage device" would not reasonably be interpreted as conveying carrier waves. The examiner has not provided any support for the assertion that carrier waves are devices. The applicant respectfully requests that the section 101 rejection of claims 11-19 be withdrawn.

## Section 103 Rejections

The examiner rejected claim 1 over Goodisman and Golovchinsky. Claim 1 recites identifying a target document relating to a text reference in a source document, where the identifying includes performing a search based on the text reference using a search engine.

The examiner acknowledges that Goodisman does not disclose the claimed identifying a target document. However, the examiner states that paragraphs 18 and 67 of Golovchinsky does disclose the claimed feature. The applicant respectfully disagrees.

Golovchinsky discloses techniques for detecting annotated anchors within documents. *See* paragraph 38. User annotations are identified as being near to existing anchors in a document. *See* paragraphs 14-15. The existing anchors each identify a target document or a target location within the current document. *See* paragraph 42. Thus, Golovchinsky discloses identifying existing anchors relative to user annotations.

Additionally, Golovchinsky discloses that a search <u>of the content</u> of the known target documents referenced by the anchors can be performed (e.g., to determine the meaning of a term used in a current document). *See* paragraph 71. Also, Golovchinsky discloses performing a search for documents that cite the identified target documents referenced by the annotated anchors (e.g., a hub document that is a review of some of the target documents). *See* paragraph 75.

In particular, paragraph 18 reads as follows:

[0018] An additional component of the system of the invention is the processing which may occur on the annotated anchors once detected. Such processing includes: generating a list illustrating the documents that are targets of annotated anchors, with or without the annotation metadata, to allow for deferred link following; constraining the list illustrating the target documents; searching a document database for documents containing one or more references to these target documents; pre-fetching documents from a document database; allowing propagation of the annotations to other anchors which reference the same target in the same document or in other documents and/or hypertext structures; and suppressing or enhancing links based on defined annotation structures. The list may be generated from any serializable structure, such as hierarchical, spatial, sequential, etc.

Paragraph 18 discloses that following the identification of existing annotated anchors, additional processing can be performed. This includes generating a list of target documents identified by the annotated anchors. The target documents for the annotated anchors are known since the anchor references the target document. The cited paragraph does not disclose or suggest searching for a target document based on identified text, as required by claim 1.

Additionally, the reference to "searching" in paragraph 18 refers to a search for documents that reference the target documents. Thus, the search is based on the target documents and not on the text reference in the source document. There is no reference in the cited paragraph of searching for a target document based on a text reference in a source document. Moreover, Golovchinsky explicitly recites existing anchors that already reference target documents. Therefore, paragraph 18 of Golovchinsky fails to disclose or suggest identifying a target document relating to the text reference, where the identifying includes performing a search based on the text reference using a search engine.

Paragraph 67 reads as follows:

[0067] The list may be formatted according to any user created attributes and may include annotations from one, two, or as many documents as desired. For example, list 600 is formatted based on the order in which the annotated anchors 601-607 first appear in the document titled "Yeung et al., 1998." Additionally, a reader may select to group annotations containing anchors which point to the same target. For example, in FIG. 6A annotations 609 and 611 both include an anchor which points to the same target document. Thus, annotations 609 and 611 may be grouped and listed under the same anchor 601.

The cited paragraph of Golovchinsky describes an example "to-read" list shown in FIG. 6A. A "to-read" list is a list of identified annotated anchors. *See* paragraph 61. The to-read list of FIG. 6A includes a list of anchors identifying particular target documents and their associated text in the source document. The cited paragraph does not disclose or suggest any searching for target documents. Again, as stated above, the target documents are already known because existing anchors are identified. Therefore, the cited portion of Golovchinsky does not disclose or suggest identifying a target document relating to the text reference, where the identifying includes performing a search based on the text reference using a search engine.

Consequently, the examiner has failed to make a *prima facie* case for obviousness under section 103.

To establish a *prima facie* case of obviousness, three basic criteria <u>must</u> be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, <u>the prior art reference</u> (or references when combined) <u>must teach or suggest all the claim limitations</u>. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [MPEP § 2142 (emphasis added)]

As set forth above, the examiner has failed to show that the actual claim limitations are taught or suggested by the references. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then <u>without more</u> the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis added). Therefore, the applicant respectfully submits that claim 1 is in condition for allowance.

Independent claims 11 and 20 include limitations corresponding to those of independent claim 1 and were rejected for the same reasons. It is therefore submitted that claims 11 and 20 are in condition for allowance for at least the same reasons as set forth above.

Additionally, claims 2-10, 12-19, and 21-30, which depend from claims 1, 11, and 20, are in condition for allowance for at least the same reasons.

Claim 29 was rejected over Goodisman and Golovchinsky. Claim 29 recites identifying a target document relating to the text reference at least in part based on a search performed by a search engine including performing the search using a search term, the search term being determined based on the text reference.

The examiner states that paragraph 71 of Golovchinsky discloses this claimed feature. The applicant respectfully disagrees. Paragraph 71 of Golovchinsky reads as follows:

> [0071] Additionally, if a reader wishes to determine the meaning of a technical term used within the document they are currently reading, the constraint search process 406 will search the target documents which the annotated anchors point to and provide an overview of how the term is used in these documents. This overview may be displayed in a format similar to that shown in FIGS. 6A and 6B. Alternatively, the results may be ranked or filtered by the number of annotated anchors for each returned document, the types of annotations on the anchors, the type of the link that was annotated, etc.

The cited portion of Golovchinsky discloses that the target documents can be searched to identify a meaning of a particular technical term from the current document. Thus, as set forth above with respect to claim 1, in Golovchinsky the target documents referenced by the anchors in the current document are known. The search is being performed on content within the target documents, not a search for the target documents themselves. Claim 29, by contrast, requires that the target document is identified in part based on a search using a search term based on the text reference.

The applicant respectfully submits that claim 29 is allowable.

Claim 30 was rejected over Goodisman and Golovchinsky. Claim 30 recites determining a target document according to a rating determined by the search engine. The examiner states that paragraph 71 of Golovchinsky discloses the claimed determining the target document. The applicant respectfully disagrees.

Paragraph 71 of Golovchinsky discloses ranking the results of a search of the target documents for a particular term. The cited portion of Golovchinsky does not disclose or suggest searching for a target document as it is the target documents themselves that are being searched. By contrast, claim 30 requires the determining of the target document according to a rating determined by the search engine. The applicant respectfully submits that claim 30 is in condition for allowance.

## Conclusion

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the applicant's decision to amend or cancel any claim should not be understood as implying that the applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

Please apply any credits or charges to Deposit Account No. 06-1050.

Respectfully submitted,


Date: <u>November 10, 2008</u>                    /Brian J. Gustafson/
                                                 Brian J. Gustafson
                                                 Reg. No. 52,978


**Customer No. 26192**
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50618465.doc